

REMARKS

Upon entry of the foregoing amendments, claims 1, 2, 6-9, 13-16, and 20-21 have been amended, and claim 23 has been newly added. No claims have been cancelled. Therefore, claims 1-23 are pending. The amendments to the claims are not narrowing and have not been made to overcome prior art. The amendments to the claims have been made for consistency only. Support for the instant amendments is provided throughout the as-filed specification. Thus, no new matter has been added. In view of the following remarks, allowance of all pending claims is requested.

A. CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Pub No. 2003/0097361 A1 by Huang et al. (“Huang”) in view of Barnes, Kate, “10 Minute Guide to Windows 3.1” (“Barnes”). Applicant traverses the rejection of claims 1-22 for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

Three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). The requirements are: (1) the prior art must teach or suggest all the claims limitations; (2) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings; and (3) there must be a reasonable expectation of success. MPEP §2142.

In the Office Action mailed Oct. 27, 2004 (“Office Action”), at pg. 3, the Examiner concedes that Huang fails to disclose storing a created list in a system clipboard, as disclosed and claimed by Applicant in independent claims 1, 8, and 15. The Examiner relies on Barnes, however, for this feature. Applicant submits that there exists no teaching, suggestion, or motivation to modify Huang to include the teachings of Barnes.

Assuming arguendo that there was a teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Huang and Barnes, even when combined, fail to disclose, teach, or suggest all of the elements of independent claims 1, 8, or 15.

For example, independent claims 1, 8, and 15 each recite, *inter alia*, the claim element of “*for each document selected by the user, the list includes ... a hyperlink to the selected*

• *document.*” In the Office Action, at pg. 3, the Examiner alleges that this claim element is disclosed by Huang at paragraphs 0084-0085, and FIGS. 7A-7B. Applicant disagrees.

The passages of Huang relied upon by the Examiner appear to teach the attachment of files to an email. Applicant submits that a hyperlink is not created in Huang, however, because a link to the selected file is not created. By contrast, the attached file in Huang appears to be a copy of the selected file. Thus, in Huang, if the selected file were altered, the file attached to (and linked to) the email would not reflect the alterations. As such, the passages relied upon by the Examiner in Huang do not appear to teach a hyperlink as recited by Applicant in claims 1, 8, and 15. The addition of Barnes fails to cure this deficiency. As such, the Examiner has not shown that Huang and Barnes, even when combined, teach or suggest all the elements of independent claims 1, 8, or 15. Thus, the Examiner has not established a *prima facie* case of obviousness for independent claims 1, 8, and 15, and the rejections thereto must be withdrawn.

For at least the reasons set forth above, Applicant submits that none of the references cited by the Examiner, either alone or in combination, teach all of the limitations of independent claims 1, 8, and 15. Accordingly, Applicant further submits that dependent claims 2-7, 9-14, and 16-22 are allowable because they depend from allowable independent claims, as well as for the further limitations they contain.

CONCLUSION

Having addressed each of the foregoing objections and rejections, it is submitted that a full and complete response has been made to the outstanding Office Action. Applicant requests that the Examiner reconsider and withdraw the pending objections and rejections, consider the new claims, and indicate the allowance of all pending claims.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided

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